

## REMARKS

In the outstanding Office Action, the Examiner rejected claims 1-14. Claims 1-3, 7, 9-14 are amended herein. No new matter is presented. Support for the amendments can be found at least on page 32, lines 6 through 12 of the Specification.

Thus, claims 1-14 are pending and under consideration. The rejections are traversed below.

### REJECTION UNDER 35 U.S.C. § 112:

Claim 2 was rejected under 35 U.S.C. § 112, first paragraph.

Applicants respectfully submit that support for features of claim 2 pointed out by the Examiner can be found at least on page 28, line 23 through page 29, line 10 with respect to operation 28 of Fig. 13 concerning the restoration process which is described in more detail starting on page 35, line 6 with respect to Fig. 16.

Further, claim 2 is amended herein to recite, "a searching device searching the structured document after being converted, with the search key, extracting..." to better clarify the claimed invention.

Therefore, withdrawal of the rejection is respectfully requested.

### REJECTION UNDER 35 U.S.C. § 112:

Claims 2-8 were rejected under 35 U.S.C. § 112, second paragraph. As mentioned above, claim 2 is amended herein.

At item 11 of the outstanding Office Action, the Examiner indicated that it is unclear which elements the joining device refers to and how they are being combined as synthesis targets.

The text elements combined as synthesis targets in claim 3 include (1) "content of each element included in a first combination of elements that successively exist side by side in a level immediately below a certain element and have a same element name", and (2) "content of each element included in a second combination of elements that have a same element name in a certain level lower than the elements of the first combination."

The relationship of the elements of the first combination and the certain level in claim 3 is defined such that elements in each level on a route from the elements of the first combination to

a certain level have "a same element name." It is respectfully submitted that these features are now clear in amended claim 3. Claims 4-8 depend from claim 3.

Therefore, withdrawal of the rejection is respectfully requested.

**REJECTION UNDER 35 U.S.C. § 101:**

Claim 10 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claim 10 is amended herein.

Therefore, withdrawal of the rejection is respectfully requested.

**REJECTION UNDER 35 U.S.C. § 102(e):**

Claims 1, 3, 7 and 9-14 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,300,947 (Kanevsky).

Kanevsky does not teach or suggest "combining contents of text elements relatively with a same path from a root among two records or more of the structured document" and "converting the structured document by replacing the two records or more with the new record, thereby decreasing the number of hierarchical elements of the structured document and preserving text element information of the records", as recited in claim 1. Independent claims 9-11 recite similar features.

Instead, Kanevsky discusses producing a stripped version of a web page in which information is stripped or has been removed from the web page (see, Fig. 7 which shows an original version 701 with, for example, the text "Health" and a stripped version 702 that does not contain this text). That is, Kanevsky destroys the other records and the information is lost.

Kanevsky does not teach or suggest "combining content of each element included in a first combination of elements that successively exist side by side in a level immediately below a certain element and have a same element name" and "content of each element included in a second combination of elements that have a same element name in a certain level lower than the elements of the first combination", as recited in claim 3.

In contrast to "decreasing the number of hierarchical elements of the structured document and preserving text element information of records" as recited in claim 3, Kanevsky generates a stripped version of the webpage by removing text from the web page (see, Fig. 13 including corresponding text).

Claim 12 recites, "combining hierarchical text elements of the hierarchically structured document responsive to common element names for the hierarchical text elements and a common child element structure of the hierarchical text elements" and "preserving text element information of the text elements."

Similarly, claims 13 and 14 recite "combining text elements" and "text element information of the text elements."

Therefore, Kanevsky does not disclose or suggest at least the feature of "combining contents of text elements" and "preserving text element information", as recited in each of the independent claims (see above detailed discussion of claims). Accordingly, Kanevsky does not disclose every element of the Applicants' independent claims. In order for a reference to anticipate a claim, the reference must teach each and every element of the claim (MPEP §2131). Therefore, since Kanevsky does not disclose the features recited in independent claims, as stated above, it is respectfully submitted that the independent claims patentably distinguish over Kanevsky.

The dependent claims are also patentable. For example, claim 7 recites, "said joining device consecutively inserts the delimiter in the contents of the new elements if content of an element which becomes the synthesis targets is lacking." Kanevsky does not teach or suggest these features of claim 7.

Therefore, withdrawal of the rejection is respectfully requested.

#### **REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 2 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kanevsky in view of U.S. Patent No. 6,105,044 (DeRose).

For at least the previously discussed reasons with respect to claim 1, dependent claims 2 and 8 are patentably distinguish over Kanevsky. Further, as DeRose merely discusses producing a digital form of a portion of a hierarchical digital document, DeRose does not cure the deficiencies of Kanevsky regarding claims 2 and 8 of the present application.

However, DeRose is silent regarding combining and restoring a record before being converted.

Kanevsky and DeRose, alone or combination, fail to teach or suggest combining contents of text elements "searching", "extracting a character string corresponding to a position

of a detected character string from contents of an element in a certain record..., restoring a record before being converted" and "outputting the restored record as a search result", as recited in claim 2.

Kanevsky and DeRose do not teach or suggest "comparing a character string between two delimiters with a character string of the search key", "extracting a character string between a delimiter corresponding to the order and a next delimiter" and "restoring a corresponding portion of the structured document before being converted from the detected character string and the extracted character string", as recited in claim 8.

Even assuming *arguendo* that DeRose does disclose the features discussed by the Examiner, the Applicants respectfully submit that there is no motivation to combine the cited references. The Examiner stated that the combination of the references would be obvious because of all the reasons taught by DeRose including to allow users to navigate readily an electronic document and to manipulate such document in an efficient manner (see at least page 11 of the outstanding Office Action).

MPEP §2143.01 states that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reasoning that leads to a legal conclusion of obviousness. Therefore, as there is no requisite reasoning to combine the references cited by the Examiner, the Applicants respectfully request the withdrawal of the Examiner's §103 rejections.

The record, however, fails to provide the required evidence of a motivation for a person of ordinary skill in the art to perform such modification. While DeRose discusses searching and formatting documents, Kanevsky fails to suggest why a person of ordinary skill in the art at the time of the invention would be motivated to incorporate searching of only a portion of a document generated based on selected elements as discussed in DeRose.

In light of the above, there is no support, within the record of a motivation for modifying the Kanevsky system by incorporating DeRose. Without such motivation and absent improper hindsight reconstruction, a person of ordinary skill in the art would not be motivated to perform the proposed modification, and the claimed invention is believed to be non-obvious and patentable over Kanevsky and DeRose.

Therefore, withdrawal of the rejection is respectfully requested.

**CONCLUSION:**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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